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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,802	07/18/2005	Guenter Farin	E7900.2002/P2002	1166
24998 7590 07/25/2008 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403				
EXAMINER				
CHEN, VICTORIA W				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/525,802

Applicant(s)

FARIN ET AL.

Examiner

VICTORIA W. CHEN

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-45 and 47 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 20-45 and 47 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 4/3/07 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

The indicated allowability of claims 22, 27-33 and 38 is withdrawn in view of the newly interpreted reference(s) to Cosmescu (US 6149648) and new 35 USC 112 rejections caused by amendment. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-38 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites the cutting electrode being distal to the first end of the applicator where the gas and high frequency terminal is located (ll. 2-4), however the specification discloses the distal end being the end where the gas and high frequency terminal is located and the proximal end as being where the electrode is located (Specification, pg. 4, ll. 16-18).

Claim 45 has the limitation "to limit said displacement thereof relative to the supply pipe" in ll. 2-3. It is unclear what element is being displaced relative to the supply pipe.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 20, 21, 23-26, 30, 32, 35-44 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosmescu (US 6149648), hereon referred to as Cosmescu, in view of Cosmescu (US 5836909), hereon referred to as Cosmescu'.

Regarding claims 20, 24 and 26, Cosmescu teaches an applicator [124] for an electrosurgical instrument comprising a gas and high frequency current terminal [113] at a first end of the applicator, a cutting electrode [112] at a second end of the applicator, an insulating cap [101] configured to detachably fasten the applicator on a handle of the instrument [col. 9, ll. 56-60], a gas and high frequency current supply pipe [109 & 106] formed of an electrically conductive material and attached to said cutting electrode, said pipe forming a passage that communicates gas from said gas and high frequency current terminal to a location proximate to the cutting electrode [Fig. 5, gas channel 160 is within 109] said conducting material of said pipe conducting a high frequency current that drives said cutting electrode [col. 8, ll. 41-44 and ll. 49-57], an insulating casing tube [111] displaceable relative to a common longitudinal axis of the applicator for exposing or covering the cutting electrode [col. 9, ll. 31-34], the casing tube surrounding the gas and high frequency current supply pipe over a longitudinal section and an external right-angle bend at a distal end of casing tube [Fig. 6B, right angle at top near label 151]. Cosmescu further teaches a locking system

which allows for the position of the casing tube to be fixed at different locations [102, 163], and further teaches that any other type of locking device is possible [col. 9, ll. 29-39]. However, Cosmescu fails to specifically teach a radially surrounding gas sealing inhibiting device arranged between an inside of the casing tube and an outside of the gas and high frequency supply pipe. Cosmescu' teaches an electrosurgical instrument having a casing tube [112] capable of exposing or covering a cutting electrode [130, Fig. 5a] having a radially surrounding gas-sealing inhibiting device, disclosed as an O-ring, [142] arranged in a radially surrounding groove [Fig. 5a] around the electrode so as to prevent gas from escaping and fixing the casing tube to the rest of the applicator [114, col. 11, ll. 15-24]. Therefore it would have been obvious to one of ordinary skill of the art to modify the applicator as taught by Cosmescu with the O-ring inhibiting device as taught by Cosmescu' in order to prevent gas from escaping and to allow the casing tube to be fixed to the rest of the applicator. Furthermore, because both Cosmescu and Cosmescu' teach locking devices, it would have been obvious to one skilled in the art to substitute the O-ring inhibiting device as taught by Cosmescu' for the other to achieve the predictable result of frictionally fixing the casing tube to the outside of the gas and high frequency current supply pipe.

Regarding claim 21, Cosmescu in view of Cosmescu' teaches the inhibiting device is located in a portion of a proximal extension of the insulating cap [Fig. 5, element 111 surrounds proximal extension of insulating cap 101].

Regarding claim 23, Cosmescu teaches a hollow cylindrical partially outwardly projecting insert [154] arranged at a proximal outer end of casing tube.

Regarding claim 25, Cosmescu in view of Cosmescu' teaches the invention as claimed, including a radially surrounding groove for accommodating the inhibiting device on the gas and high frequency current supply pipe, but fail to teach the groove located on the casing tube. It would

have been an obvious matter of design choice to a person of ordinary skill in the art to modify the groove as taught by Cosmescu in view of Cosmescu' by putting it on the casing tube instead of the supply pipe because Applicant has not disclosed that the groove on the casing tube provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the groove located on the supply pipe as taught by Cosmescu in view of Cosmescu', because it provides frictional locking means and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Cosmescu in view of Cosmescu'. Therefore, it would have been an obvious matter of design choice to put the groove on the casing tube to obtain the invention as specified in the claim(s).

Regarding claim 30 and 38, Cosmescu teaches the insulating cap [101] has the shape of a truncated cone [Fig. 5] with a cap closing piece [29, 27] made integral with a hollow cylindrical recess of an upper surface of the truncated cone [Fig. 3].

Regarding claim 32, the flanges [29] are interpreted as an internal collar.

Regarding claim 35, Cosmescu teaches the cutting electrode [112] is attached at a proximal end of an inside of the gas and high frequency current supply pipe [109 & 106, Fig. 5].

Regarding claims 36 and 37, Cosmescu teaches the cutting electrode comprises a fastening support pipe [108] at its distal end which adjusts the electrode coaxially within [Fig. 5A].

Regarding claims 39 and 41, Cosmescu teaches an applicator [124] for an electrosurgical instrument comprising a gas and high frequency current supply pipe [109 & 106] formed of an electrically conductive material, an electrode [112] attached to supply pipe, an insulating member [111], in the form of a tube [Fig. 5], configured to surround a longitudinal section of the supply pipe [Fig. 5], said pipe forming a passage that communicates gas flow [Fig. 5, gas channel 160 is within

109], said conducting material of said pipe conducting a high frequency current that drives said electrode [col. 8, ll. 41-44 and ll. 49-57], said insulating member configured for displacement relative to said supply pipe in the direction of a longitudinal axis of said supply pipe [col. 9, ll. 31-34]. Cosmescu further teaches a locking system which allows for the position of the insulating member to be fixed at different locations [102, 163], and further teaches that any other type of locking device is possible [col. 9, ll. 29-39]. However, Cosmescu fails to specifically teach sealing member between an inside of the insulating member and an outside of the supply pipe. Cosmescu' teaches an electrosurgical instrument having an insulating member [112] capable of exposing or covering an electrode [130, Fig. 5a] having sealing member arranged around the electrode so as to prevent gas from escaping and fixing the insulating member to the rest of the applicator [114, col. 11, ll. 15-24]. Therefore it would have been obvious to one of ordinary skill of the art to modify the applicator as taught by Cosmescu with the sealing member as taught by Cosmescu' in order to prevent gas from escaping and to allow the insulating member to be fixed to the rest of the applicator. Furthermore, because both Cosmescu and Cosmescu' teach locking devices, it would have been obvious to one skilled in the art to substitute the sealing member as taught by Cosmescu' for the other to achieve the predictable result of frictionally fixing the insulating member to the outside of the gas and high frequency current supply pipe.

Regarding claim 40, Cosmescu teaches the insulating member is displaceable relative to a common longitudinal axis of the applicator for exposing or covering the electrode [col. 9, ll. 31-34].

Regarding claim 42, Cosmescu' teaches the seal [142] is a fluid proof seal [col. 11, ll. 15-24].

Regarding claim 43, Cosmescu teaches an insulating cap [101] for detachably fastening the applicator on the handle of the instrument [col. 9, ll. 56-60].

Regarding claim 44, Cosmescu teaches the supply pipe [106 & 109] extends through said insulating cap [Fig. 5].

Regarding claim 47, Cosmescu teaches the electrode [112] is connected to the supply pipe [106 & 109] via an inner surface of the supply pipe [via element 123].

Claims 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosmescu (US 6149648), hereon referred to as Cosmescu, in view of Cosmescu (US 5836909), hereon referred to as Cosmescu' in further view of Fleenor (US 5306238).

Cosmescu in view of Cosmescu' teach the invention as claimed, but fail to specifically teach the insert made of ceramics. Fleenor teaches a gas enhanced electrosurgical instrument [10] with a protruding insert [15] at a proximal end made from ceramic in order to withstand the heat generated by the instrument during use [col. 5, ll. 63-65]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the insert by making it ceramic as taught by Fleenor in order to withstand the heat generated by the instrument during use.

Response to Arguments

Applicant's arguments with respect to claims 20-45 and 47 have been considered but are moot in view of the new ground(s) of rejection. Furthermore, applicant's new amendments have caused 35 USC 112 issues addressed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA W. CHEN whose telephone number is (571)272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victoria W Chen/
Examiner, Art Unit 3739

/Henry M. Johnson, III/
Primary Examiner, Art Unit 3739